

PATENT
Customer No. 22,852
Attorney Docket No. 08350.1767-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of:)
Dario SANSONE et al.) Group Art Unit: 3611
Application No.: 10/659,794) Examiner: Kevin HURLEY
Filed: September 11, 2003)
For: VEHICLE WITH RETRACTABLE) Confirmation No.: 4545
AND STEERABLE REAR WHEEL)

MAIL STOP: REISSUE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY TO PROTEST

Wirtgen American, Inc. filed a Protest under 37 C.F.R. § 1.291 in this reissue application on August 28, 2009 ("the Protest"). The Protest was filed after Applicant filed the Reply to Office Action on August 7, 2009 ("the Reply") and alleged that claims 122-146 are not patentable because they improperly recapture surrendered subject matter and alleged that claims 115 and 116 are not patentable because they are improper dependent claims. Protest at p. 2.

Regarding claims 122-146, the Protest alleged that the addition of the materially narrowing overlooked feature included in these claims and discussed in the Reply did not satisfy the third-step of the test for recapture because it (i) broadened the patent claims and (ii) was not overlooked. Id at pp. 2-5. Regarding claims 115 and 116, the

Protest alleged that these claims subtract or eliminate an element of independent claims 1 and 9, from which they depend. Id at pp. 5-6.

Applicant disagrees with the alleged grounds of protest and wishes to comment on them as set forth below.

Claims 122-146 - reissue claims can be broader than the original patent claims and include a “materially narrowing” feature

Initially, Applicant does not necessarily concede that the feature—“only one” of the rear supports is steerable—is a “broadening” feature as alleged in the Protest. Nonetheless, assuming arguendo that “only one” steerable rear support is a “broadening” feature, it appears that the Protest alleges in § (I)(1) that a reissue claim cannot be broader than the original patent claims (i.e., be a broadening reissue application) and at the same time include a materially narrowing feature (i.e., to avoid recapture of surrendered subject matter). This contention is misplaced. Additionally, it appears that the Protest conflates the standard for determining whether reissue claims are “broadened” as compared to the scope of the patent claims under the two-year bar requirement of 35 U.S.C. § 251 and the standard for determining whether reissue claims are “narrowed” as compared to the scope of the patent claims under the requirements of the third step of the recapture test.

The Protest begins its discussion of § (I)(1) by stating that the “change requiring ‘only one’ instead of both rear supports to be steerable, broadens the reissue claims as compared to the patent claims.” Id at p. 3. (Emphasis in original). Thereafter, the Protest quotes the general standard for determining whether or not a claim of a reissue application is broader in scope than the patent claims to determine whether or not a reissue claim is prohibited under the 35 U.S.C. § 251 two-year bar for broadening

reissue applications. Id at II. 13-15. The Protest then quotes the standard under the first step of the recapture test, which requires a determination of whether and in what aspect reissue claims are broader than the original patent claims. Id. Finally, the Protest makes an unsubstantiated conclusion that “[a] broadening change by definition cannot be a ‘materially narrowing’ change and cannot satisfy the third step of the recapture test.” Id at p. 4.

In actuality, however, reissue claims can be “broader” than the original patent claims because they include in their scope apparatus that would not have infringed the original patent claims and at the same time include a “materially narrowing” overlooked feature to avoid recapture. This scenario is expressly described two of the examples set forth in M.P.E.P. § 1412.02 (V). Example (2) describes a reissue claim **ABCDF** that eliminates a surrender generating limitation **E** from an original patent claim of **ABCDE** and adds a materially narrowing limitation **F**. M.P.E.P. Eight Edition, Rev. 7 (July 2008) § 1412.02(V). Example (4) describes a reissue claim **ABCDE_{BROADER}F** that broadens a surrender generating limitation **E** from an original patent claim **ABCDE** and adds a materially narrowing feature **F**. Id. In each of these examples, the reissue claim is broader than the original patent claim, by eliminating or broadening limitation **E**, but also avoids recapture because they also include a materially narrowing feature **F**.

In essence, such scenarios are exactly the types of situations where the third step of the recapture is applicable. If a reissue claim is not broadened in any respect as compared to the patent claims, there can be no recapture. M.P.E.P. §§ 1412.(I)(A), (I)(C)(1)(b). If there is no recapture, there is no need to further analyze the reissue claim to determine if it also includes a materially narrowing feature. See *id.*

M.P.E.P. § 1412.02 (I)(C) describes the analysis with respect to determine if an added feature is materially narrowing and states that “reissue claim(s) [that] are really claiming additional inventions/embodiments/species not originally claimed (i.e., overlooked aspects of the disclosed invention)” avoid recapture. Thus, in contrast to the Protest’s unsubstantiated conclusion, “[a] limitation is said to ‘materially narrow’ the reissue claims if the narrowing limitation is directed to one or more ‘overlooked aspects’ of the invention. *Id.*; *Hester Industries Inc., v. Stein, Inc.*, 142 F.3d 1472 (Fed. Cir. 1998).

As described above and outlined in the M.P.E.P., the standard for determining whether an added feature “materially narrows” a reissue claim is whether or not that feature was “overlooked” during original prosecution. There is no requirement that the resulting reissue claims that include the “materially narrowing” feature be narrower in scope when compared to the original patent claims. Accordingly, Applicant submits that the Protest’s ground of protest regarding the alleged unpatentability of claims 122-146 is misplaced.

Claims 122-146 - the feature that “only one” of the rear supports is steerable was overlooked during original prosecution

The Protest alleges in § (I)(2) that the feature of “only one” rear support being steerable was not an overlooked aspect during original prosecution. In particular, the Protest alleges that the “issue of the number of rear supports to be steered was the express subject of the arguments made during prosecution which created the surrender of claim scope that is now being recaptured.” Protest at p. 4. In an effort to support this allegation, the Protest emphasizes part of Applicant’s arguments presented during original prosecution and cites to *Ex Parte Beale* (Appeal 2007-1432 Bd. App. & Int.

August 2007) to conclude that a materially narrowing overlooked feature cannot relate to surrendered subject matter. *Id.* at pp. 4-5.

In particular, the Protest emphasizes the following statement made with respect to original patent claims 9-11 during the original prosecution: "The prior art also lacks a pair of rollable rear supports that are pivotable about a rear vertical axis and are controlled by a steering hydraulic cylinder." *Id.* Immediately thereafter, the Protest concludes that "[a]n aspect of the claims which was the express subject of the original prosecution cannot qualify as 'overlooked.'" *Id.* The Protest cites to *Ex Parte Beale* at 17 to support its conclusion. *Id.*

Ex Parte Beale was merely issued as a Board opinion in support of the underlying decision in that specific appeal and was explicitly indicated as "not binding precedent of the Board." *Ex Parte Beale* at 1. (Emphasis in original.) Thus, it is not controlling on proceedings before the USPTO. Additionally, *Ex Parte Beale* was not issued as an informative decision Board decision; nor was it included as part of the USPTO's recently instituted policy on recapture in reissue applications specifically referenced and relied upon as part of the recapture rejection set forth in the Office Action dated February 10, 2009 ("the Office Action"). See Office Action at pp. 6-9.

The Protest cites to page 17 of *Ex Parte Beale*, which is merely the beginning of several pages of a generic discussion relating to alleged recapture law principles. *Ex Parte Beale* at 17-42. Most of this discussion has no bearing or relevance to the particular facts of the case at issue in *Ex Parte Beale*; nor was it required to support the panel's holding. It is primarily dicta. Upon review of *Ex Parte Beale*, the discussion therein with respect to materially narrowed overlooked aspects begins instead on page

34. *Ex Parte Beale* provides some discussion relating to a perceived grammatical distinction regarding the Federal Circuit's language in *North American Container* describing the analysis of the third-step of the recapture test. However, this particular characterization by the panel of *North American Container* has no bearing on the determination of the issues in *Ex Parte Beale*.

For example, the Appellant in *Ex Parte Beale* first argued in part that the claims on appeal were materially narrowed because they included an overlooked aspect. Id at 44-47. Regarding the overlooked aspect analysis, however, the particular facts of *Ex Parte Beale* related to the failure of the Appellant to meet its burden and sufficiently show that its failure to explicitly import a limitation from one application claim into another application claim established an overlooked aspect. Id at 46-47. This conclusion is not based on any distinction or analysis to determine if the subject matter of the materially narrowing overlooked aspect relates to the subject matter of the surrender generating feature.

Additionally, *Ex Parte Beale* was decided in August 29, 2007. The latest edition of the M.P.E.P. is the Eighth Edition originally published in 2001 revised by Revision 7 published July 2008. This is the most recent edition of the M.P.E.P. and it was issued almost one year after the decision in *Ex Parte Beale*. Although the M.P.E.P. does not have the force of law, “[i]t contains instructions to examiners, as well as other material in the nature of information and interpretation, and outlines the current procedures which the examiners are required or authorized to follow in appropriate cases in the normal examination of a patent application.” M.P.E.P., Forward. The M.P.E.P. sets forth the current USPTO understanding of applicable statutes, rules, and decisions that control

the proceedings before the USPTO. Id. The latest edition of the M.P.E.P. specifically revised § 1412 as follows:

To add discussion of the Federal Circuit decision of *North American Container, Inc. v. Plastipak Packaging, Inc.* Discussion of the Board decision, *Ex Parte Eggert*, has been deleted. A new subsection V. directed to rebuttal by the reissue applicant to a recapture rejection has been added. The recapture-analysis flowchart has been revised.

See M.P.E.P. Blue Pages, p. 6. (Emphasis added.) In particular, and as discussed above, M.P.E.P. § 1412.02 (I)(C) describes the analysis with respect to determining if an added feature is materially narrowing and states that “reissue claim(s) [that] are really claiming additional inventions/embodiments/species not originally claimed (i.e., overlooked aspects of the disclosed invention)” avoid recapture.

Furthermore, to the extent non-precedential, non-informative Board decisions like *Ex Parte Beale* are applicable to proceedings of the USPTO, *Ex Parte Mostafazadeh* (Appeal 2009-004238 Bd. App. & Int. August 2009) further notes the applicability of the latest version of the M.P.E.P. with respect to recapture analysis and, in particular, the analysis of “overlooked aspects.” *Ex Parte Mostafazadeh* at p 8. Accordingly, Applicant respectively asserts that the Protest’s reliance on *Ex Parte Beale* is misplaced and makes its conclusion regarding the alleged scope of subject matter for a materially narrowing aspect unsubstantiated.

Claims 115 and 116

The Protest alleges in § (II) that claims 115 and 116 are unpatentable because they allegedly do not further limit independent claims 1 and 9 on which they depend. In particular, the Protest alleges that claims 115 and 116 improperly attempt to eliminate the requirements of claims 1 and 9 that both rear supports be rotatable. Protest at pp.

5-6. For at least the reasons set forth below, Applicant disagrees with the Protests allegations.

In an effort to support its allegation, the Protest misconstrues the claim language of claim 115 by selectively quoting portions thereof. The Protest misleads the reading of claim 115 by alleging it recites "only one of the rear supports ... is configured to be rotatable about the rear vertical axis." Id at p. 5. The Protest's mischaracterization of claim 115 is apparent when reading the full claim 115 in conjunction with independent claim 1.

Independent claim 1 includes a machine having "at least one pair of rollable rear supports ... [and] a maneuvering system ... for rotating said rear supports about [a] rear vertical axis." Claim 115 further limits the machine of claim 1 to include "only one of the rear supports [being] configured to move inward of said frame and [that rear support being] configured to be rotatable about the rear vertical axis only when positioned inward of said frame." That is, claim 1 includes a machine having at least one pair of rollable rear supports rotatable about rear vertical axis and claim 115 further limits the machine of claim 1 to have only one rear support configured to move inward of the frame and be rotatable about the rear vertical axis only when it is in the inward position. Thus, claim 115 does further claim 1.

Similarly, the Protest misconstrues the claim language of claim 116 by selectively quoting portions thereof. The Protest misleads the reading of claim 116 by alleging it recites "only one of said rear supports is pivotable about the rear vertical axis." Id at p. 6. The Protest's mischaracterization of claim 116 is apparent when reading the full claim 116 in conjunction with independent claim 9.

Independent claim 9 includes a steerable machine having "at least one pair of rollable rear supports, said rear supports being pivotable about a rear vertical axis[,] ... rear steering means ... for steering said rear supports ... [and] a maneuvering system ... for operating ... said rear steering means." Claim 116 further limits the steerable machine of claim 9 to include "only one of said rear supports [being] pivotable about the rear vertical axis ... between an extended position and a retracted position [and that rear support being] steerable only when in said retracted position." That is, claim 9 includes a steerable machine having at least one pair of rollable rear supports pivotable about rear vertical axis and claim 116 further limits the steerable machine of claim 9 to have only one rear support pivotable to a retracted position and being pivotable about the rear vertical axis only when it is in the retracted position. Thus, claim 116 does further limit claim 9.

Accordingly, Applicant respectfully asserts that the Protest's allegations that claims 115 and 116 are not patentable are misplaced.

If there is any fee due in connection with the filing of this Reply to Protest, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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